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Technology Center 2100

Paper No. 8

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In re Application of: Gary Keorkunian et al.)
Application No. 09/753,714) **DECISION ON PETITION FOR**
Attorney Docket No. 109246.00103) **ACCELERATED EXAMINATION**
Filed: January 4, 2001) **UNDER 37 CFR §1.102(d) and MPEP**
For: SYSTEM AND METHOD FOR) **§ 708.02(VIII), Accelerated Examination**
ANONYMOUS OBSERVATION AND USE)
OF PREMIUM CONTENT)

This is a decision on the petition, filed January 14, 2003 under 37 CFR § 1.102(d) and MPEP § 708.02(VIII): Accelerated Examination, to make the above-identified application special.

The petition is **DISMISSED**.

MPEP § 708.02, Section VIII that sets out the prerequisites for a grantable petition for Accelerated Examination under 37 CFR §1.102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

- (A) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);
- (B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status.

The election may be made by applicant at the time of filing the petition for special status. Should applicant fail to include an election with the original papers or petition and the Office determines that a requirement should be made, the established telephone restriction practice will be followed. If otherwise proper, examination on the merits will proceed on claims drawn to the elected invention.

If applicant refuses to make an election without traverse, the application will not be further examined at that time. The petition will be denied on the ground that the claims are not directed to a single invention, and the application will await action in its regular turn.

Divisional applications directed to the non-elected inventions will not automatically be given special status based on papers filed with the petition in the parent application. Each such application must meet on its own all requirements for the new special status;

- (C) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;

- (D) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and

(E) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references. (Italics added.)

In those instances where the request for this special status does not meet all the prerequisites set forth above, applicant will be notified and the defects in the request will be stated. The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given one opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the first renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Group Special Program Examiner.

Petitioners have submitted a petition to make special accompanied by the fee set forth in 37 CFR § 1.17(h); a statement the claims are directed to a single invention or applicants will elect without traverse; one copy of each of the references most closely related to the subject matter encompassed by the claims; a statement regarding a search made by a foreign patent office listing the field of search by class and subclass; and a statement regarding a key word search made through online patent databases by applicants' attorney. Therefore, the petition complies with items (A), (B), (C), and (D) of the items mentioned above. However, petitioners' submission is deficient regarding the detailed description requirement outlined in item (E) above.

Petitioners rely upon a search made for the PCT international patent application PCT/US01/00192, which is not claimed by applicants in their priority statement. From petitioners' statements, it would appear the International Preliminary Examination Report only addresses eight claims. In the current U.S. application, there are twelve claims pending. Therefore, without a copy of the international application, the Office cannot assume the claimed inventions are identical between the two applications.

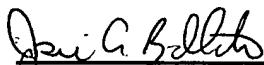
In discussing the art cited in the international search report, petitioners indicate seven references were cited in the International Search Report. Petitioners appear to rely upon the International Preliminary Examination Report to support the requirement of providing a discussion of how the claimed subject matter is patentable over the references (Part (E) of MPEP § 708.02 (VIII)). However, since petitioners have not provided a copy of the claims that were the subject of the international examination report, no weight is being given to any comments made during the international examination regarding the patentability of the claims in the PCT application for the purpose of this decision.

Regarding petitioners' detailed discussion of the first three references cited in the International Search Report, it is impossible to determine in what manner "[a]pplicants agree with the finding of the IPEA/US." As an example, on page 2 of the petition, it appears that the reference of Scholl *et al.* may have been cited as an "X" reference, while on the petition's page 3, last paragraph, applicants state: "Scholl *et al.* is cited against claim 5 for teaching...". It is not clear how an "X" reference is cited against a dependent claim, and if it is in combination with another reference, what reference was being used for the combination. Since "X" is defined as a **"document of particular relevance"**; the claimed invention **cannot** be considered to involve an **inventive step** when the document is taken alone. In discussing the reference Gabber *et al.*, the discussion is only for Claims 1-8 with no discussion of pending Claims 9-12. In addition,

Hassett et al. is only discussed relative to Claim 2 and Scholl et al. is only discussed relative to Claim 5. The record remains unclear as to whether Hassett et al. or Scholl et al. are readable on independent Claim 1.

Finally, in regards to the petitioners' discussion of the prior art found through the keyword search, the discussion is not adequate because it fails to discuss the cited prior art relative to the *claimed* invention. Petitioners discuss what is the nature of the prior art, but the discussion fails to point out with the particularity required by 37 CFR § 1.111(b) and (c) how the claimed subject matter is patentable over the references.

Accordingly, the Petition is **DISMISSED**. The application file is being forwarded to Technology Center 2100's Central Files to await examination in its proper turn based on its effective filing date. Petitioner is entitled to one opportunity to perfect the request in a renewed petition to make special. Any request for reconsideration must be filed within TWO MONTHS of the mailing date of this decision. Telephone inquiries regarding this decision should be directed to the undersigned.



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